

**II. REMARKS**

1. Claims 1-52 remain in the application.
2. Applicant notes that this is the seventh non final action for this application.
3. Applicant again traverses the non-statutory double patenting rejection over US 6,678,361 ("the '361 patent") because the present claims, if allowed, would not improperly extend the right to exclude granted in the '361 patent. The subject matter of the present claims is not disclosed in the '361 patent and the '361 patent and the present claims do not claim common subject matter. In addition, none of the present claims are anticipated by, or are obvious over any of the '361 claims.

Claim 7 of the '361 patent, cited by the Examiner, recites:

deciding by said terminal (MS) based on its capabilities (CAP), current user profile (UP) and the properties of the message provided by the notification how said received message (MM) should be handled;

There is nothing related to such a decision by the terminal in the present claims. In contrast, the present claims call for:

storing information on at least one property of the wireless terminal in the server, and

determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal.

Furthermore, the decisions themselves described in the claims are clearly different and clearly performed by different elements. The terminal in claim 7 decides how to handle the message, while the multimedia center in claim 1 decides if there is a message component that can be handled by the terminal.

Claim 7 of the '361 patent further recites:

replying by said terminal (MS) to the notification sent by said multimedia messaging service center (MMSC), therewith instructing said multimedia messaging service center (MMSC) according to the result of said decision step;

Thus, the terminal sends handling instructions to the multimedia center. There is clearly no such instruction by a terminal in the present claims.

The Examiner sustains the double patenting rejection stating that claim 7 of the '361 patent "taught the notification containing information describing the properties of the multimedia message, current user profile and how said received message should be handled." Applicant disagrees. In claim 7 the notification message clearly does not include the current user profile and how said received message should be handled. Claim 7 clearly states that the terminal decides how the received message should be handled, and that the decision is based on:

- 1) the capabilities of the terminal;
- 2) the current user profile; and
- 3) the properties of the message provided by the notification.

Contrary to the Examiner's statements the notification message does not provide how the received message should be handled. The message from the terminal in response to the notification message does.

For these reasons, Applicant submits that the subject matter of the present application is not at all disclosed in the '361 patent and that claim 1 of the present application is unrelated to claim 7 of the '361 patent and requests withdrawal of the double patenting rejection.

4. Claims 1-52 are not anticipated by Gaffney WO 98/19438 under 35 USC 102(b).

Gaffney fails to disclose or suggest determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, as recited by claims 1, 19, and 35.

Gaffney also fails to disclose or suggest the wireless terminal comprising means for requesting a component of the multimedia message to be transmitted to the wireless terminal without identifying the component, as recited by claim 43.

Gaffney discloses a method and an arrangement for handling multimedia messages in a telecommunication system. A multimedia message addressed to a particular user is stored in a multimedia message store. A user location for the user is retrieved and the user is notified of the message. A connection between the system and the user location is set up where the message presentation capabilities of the location are established and all or parts of the message are translated to be intelligible at the location. Thus, all or parts of the message are translated as a result of a connection made after the notification message where location capabilities are established.

4.1 Gaffney clearly dose not disclose or suggest determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, as recited by present claims 1, 19, and 35.

The Examiner argues that Gaffney, page 16, lines 20-25 teaches determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal. However, page 16, lines 20-25 recite "setting up a connection between said second location (SL<sub>1</sub>) and said messaging system (100) according to a dynamic dialogue (D) in which the presentation capabilities at the second location (SL<sub>1</sub>) are established." Thus, lines 20-25 on page 16 relate to setting up a connection between the second location and the messaging system, according to a dialogue in which the message presentation capabilities at the second location are established. Applicant submits that this is clearly

different from determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, as recited by claims 1, 19, and 35. The cited Gaffney passage does not relate to means for determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal.

4.2 Further, there is no disclosure in Gaffney related to a terminal comprising means for requesting a component of the multimedia message to be transmitted to the wireless terminal without identifying the component, as recited by present claim 43. None of the embodiments described in Gaffney even hint at the terminal requesting a component of a multimedia message, as recited by claim 43.

The Examiner argues that page 16, lines 25-29 of Gaffney teaches this feature. Lines 25-29 recite: "translating some or all parts of said multimedia message (M) into a message format (M'), which is intelligible at the second location (SL<sub>1</sub>) if the technological limitations of the message presentation capabilities at the second location (SL<sub>1</sub>) so demand." Applicant submit that nowhere does Gaffney disclose a terminal comprising means for requesting a component of the multimedia message to be transmitted to the wireless terminal without identifying the component.

4.3 Applicant submits that the methods described in Gaffney may be disadvantageous when applied to the embodiments as presently claimed. Gaffney establishes a connection between the messaging system and the terminal location to establish presentation capabilities each time a message is exchanged. However, the properties of the user's terminal do not necessarily change, and the transmission of properties in connection with establishment of every connection may cause unnecessary loading of the data network, such as the mobile communication network used for the transmission of the multimedia message.

At least for these reasons, Applicants submit that Gaffney does not anticipate independent claims 1, 19, 35, and 43 and dependent claims 2-18, 20-34, 36-42, and 43-52.

5. Applicant notes certain inaccuracies in the rejections of the dependent claims. Some examples follow:

5.1 Applicant notes that the Examiner cites Gaffney, Fig. 1, item 300, page 10, line 29 as teaching the features of present claims 20 and 21. Applicant disagrees. Page 10, line 29 states that a signal is sent via transport network 300 to an in/out interface (110). There is no disclosure related to selecting a bearer as recited by claims 20 and 21.

5.2 Applicant also notes that the Examiner cites Gaffney, page 19, line 21 as teaching the features of present claims 22 and 23. Applicant disagrees. Page 19, line 21 discloses location data used to locate a user to notify the user of an incoming message. There is nothing related to transmitting a notification message comprising information about at least one property of at least one multimedia component, as recited by claims 22 and 23.

5.3 Applicant further notes that the Examiner cites Gaffney, page 17, line 21 as teaching the features of present claim 24. Applicant disagrees. Page 17, line 20-22 recite a method, "characterized in that acting upon a multimedia message involves editing said multimedia message (M) into an edited multimedia message (m)." In contrast, present claim 24 recites a means for changing information on at least one property of the wireless terminal.

5.4 Applicant further notes that the Examiner cites Gaffney, page 16, lines 20-25 as teaching the features of present claim 25. Applicant disagrees. Page 16, lines 20-25 describe setting up a connection where the presentation capabilities of at a second location are established. Applicant finds no disclosure related to storing information on the storage capacity of the terminal as recited by present claim 25.

5.5 Applicant further notes that the Examiner cites Gaffney, page 16, lines 20-25 as teaching the features of present claim 27. Applicant disagrees. As mentioned above, page 16, lines 20-25 describe setting up a connection where the presentation capabilities of at a second location are established. Applicant finds no disclosure related to specifying the capability of the terminal to process multimedia messages on the basis of programs stored in, or hardware of the wireless terminal, as recited by present claim 27.

5.6 Applicant further notes that the Examiner finds the features of present claim 28 as an inherent feature of the properties or capabilities of a wireless device. Claim 28 recites that a maximum time for validity is specified for information on the properties of the wireless terminal stored in said server. Note that the information is stored in the server, thus, this feature cannot properly be an inherent feature of the wireless device. Applicants also wish to point out that a rejection based on inherency must include a rationale or evidence tending to show inherency.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency. ... To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.... (MPEP 2112 quoting *In re Rijckaert*, 9 F.3d 1531, 1534, (Fed. Cir. 1993), and *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App.&Inter. 1990), emphasis in originals).

Applicants respectfully submit that because specifying a maximum time for validity for information on the properties of a wireless terminal stored in a server is not necessarily a feature of the server or the wireless device, that the features of claim 28 are not anticipated.

6. Claims 1-52 are not anticipated by Dugan et al. (US 6,363,411, "Dugan") under 35 USC 102(e).

Dugan fails to disclose or suggest determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored

information on at least one property of the wireless terminal, as recited by claims 1, 19, and 35.

Dugan also fails to disclose or suggest the wireless terminal comprising means for requesting a component of the multimedia message to be transmitted to the wireless terminal without identifying the component, as recited by claim 43.

As recited in the Abstract, Dugan is directed to a telecommunications switching network having a resource complex including network switches, an intelligent service platform for providing intelligent call processing and service execution for call events received at the switches and requiring call processing services. A centralized administration system is provided that comprises a system for storing one or more reusable business objects that each encapsulate a distinct call-processing function, and any associated data required by the business object; a system for distributing selected business objects and associated data to selected nodes in the switching network based on pre-determined node configuration criteria; and, a system for activating the business objects in preparation for real-time use. A computing platform is provided within each node for executing those business objects required to perform a service in accordance with an event received at the network switch. Also within a node is a storage and retrieval system for sorting and retrieving selected objects and any associated data distributed by the administration system, and making them locally available to the computing platform when required to perform a service. An underlying location-independent communication system is provided to coordinate interaction of one or more business objects to perform the service in response to needs of the received event.

Applicant notes that the only reference to wireless devices is found in column 74, lines 34-40, where Dugan discloses supporting hand-off capabilities and the short message service for wireless and PCS systems.

Applicant notes that the only references to multimedia messages are found in column 66, line 13, which states that the Next Generation Intelligent Network (NGIN) supports

multimedia calls, and column 91, line 8, which states that the NGIN provides "Find Me" services that support multimedia archive access.

6.1 The Examiner states that column 16, lines 11-12 of Dugan teaches means for storing at least one property of the wireless terminal. Applicant disagrees. Applicant suggests that this citation may be incorrect (note that the same page and line numbers were presented in the Examiner's discussion of Gaffney) because column 16, lines 11-12 reads "for the same customer toll-free telephone number, Inventory Manager will detect this by performing an audit on each received data entity." Applicant submits that this has nothing to do with a means for storing at least one property of the wireless terminal, and that there is no disclosure anywhere in Dugan related to this feature.

6.2 The Examiner states that column 65, lines 35-45 of Dugan teaches means for determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal. Applicant disagrees. Column 65, lines 34-45 reads:

the NGIN may prioritize the incoming call by putting the more important call to a prioritized queue or to a reserved customer service representative; 37) the ability to provide Incoming Rate Control; i.e., offering calls to the network when it is predicted that there is capacity to handle the call. Automatic call gapping may be used to throttle calls based on dialed number; 38) the ability to load and activate a Contingency Routing Plan at any time, which, once activated, is used in place of the currently active routing plan(feature/capability); 39) the ability to provide Plan Performance Statistics which are gathered on a customer's call plan.

Applicant finds no reference to any teaching of means for determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal. The phrase "offering calls to the network when it is predicted that there is capacity to handle the call" might suggest some kind of capacity related tasks but this is not related to multimedia messages or multimedia components of multimedia messages.

6.3 The Examiner states that column 92, lines 50-61 of Dugan teaches means for selecting for transmission to the wireless terminal at least one component of the

multimedia message if there exists one or more such component(s). Applicant disagrees. Column 92, lines 50-61 reads:

The Call Queue Selection instance sub-component 1712: 1) receives operator resource requests from the Service Processor sub-component; 2) selects a call queue (CQ) 1715 to handle a request for operator services if an available operator is not currently available to handle the request; 3) determines which Call Queue sub-component shall receive the operator resource request; and 4) forwards the operator resource request information to the selected Call Queue sub-component for placement in a queue. Preferably, the Call Queue Selection sub-component is a static sub-component that is always instantiated and not destructed when service processing is complete. (Emphasis added)

This paragraph does have some kind of selections and forwarding resource requests, however, there is nothing in this passage or anywhere else in Dugan related to any selection of multimedia components to be selected for transmission.

6.4 The Examiner states that column 74, line 40 of Dugan teaches means for transmitting the selected components to the wireless terminal. Applicant disagrees. As mentioned above, this passage of Dugan only discloses supporting hand-off capabilities and the short message service for wireless and PCS systems.

At least for these reasons, Applicants submit that Dugan does not anticipate independent claims 1, 19, 35, and 43 and dependent claims 2-18, 20-34, 36-42, and 43-52.

7. Applicant would like to note certain inaccuracies in the rejections of the dependent claims over Dugan. Some examples follow:

7.1 Applicant notes that the Examiner cites column 17, lines 5-15 of Dugan as teaching the features of present claims 22 and 23. Applicant disagrees. Column 17, lines 5-15 explains how an Environment Manager, responsible for deploying services and data, is notified when a Database of Record (DBOR) is modified. There is nothing related to transmitting a notification message comprising information about at least one property of at least one multimedia component, as recited by claims 22 and 23.

7.2 Applicant also notes that the Examiner cites column 35, lines 37-47 of Dugan as teaching the features of present claim 24. Applicant disagrees. Column 35, lines 37-47 describe managing the quality of service (QoS) by a connection class manager 302. In contrast, present claim 24 recites a means for changing information on at least one property of the wireless terminal.

7.3 Applicant further notes that the Examiner cites column 58, lines 20-38 of Dugan as teaching the features of present claim 25. Applicant disagrees. Claim 25 is directed to storing information on the storage capacity of the terminal. Column 58, lines 20-38 state:

If, at step 586a, the logical name is recognized and the object reference is available, then the process proceeds to the LRM function at step 586b to determine active ("available") instances of S2 running on the SLEE 1, in accordance with certain criteria, such as utilization thresholds. If no active instances are found, the LRM may check to see if S2 is programmed to run on SLEE 1, but has not been instantiated. If this is the case, NOS 700 may decide to instantiate an instance of S2 on SLEE 1, if SLEE 1 has enough available capacity. As mentioned, the LRM at the server level only knows what is active at the server and knows what has been instantiated. If the object is currently active and instantiated at the local server level, then the object reference for instantiating a new thread for this service is returned to the SLP request. NOS will initiate instantiation of a new service thread for performing the service requested based on the returned object reference and returns an object reference if not already instantiated.

Applicant finds no disclosure related to storing information on the storage capacity of the terminal in this passage or anywhere else in Dugan.

7.4 Applicant further notes that the Examiner cites column 36, lines 35-62 of Dugan as teaching the features of claim 26. Applicant disagrees. Claim 26 is directed to storing information on the properties of wireless terminal including the capability of the wireless terminal to process multimedia components. In contrast, column 36, lines 35-62 describe a media independent service class that can be applied to different media including voice fax, email, and others. There is clearly nothing related to storing information on the capability of the wireless terminal to process multimedia components anywhere in Dugan.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

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Respectfully submitted,

  
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26 April 2007

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